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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,867	07/31/2001	A. Peter Powell	41698-1024	2424

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Alex L. Yip  
Kaye Scholer LLP  
425 Park Avenue  
New York, NY 10022

EXAMINER
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GAUTHIER, GERALD

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/918,867

Applicant(s)

POWELL ET AL.

Examiner

Gerald Gauthier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/22/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 22, 2004 has been entered.

### ***Drawings***

2. The drawings are objected to because FIG. 2 and FIG. 3 are missing labels to describe the boxes. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct

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any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claims 1-3, 5-13, 15-20, 23-27, 29-36, 38-43 and 46-47** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (US 5,504,805) in view of Matthews et al. (US 4,602,129).

Regarding **claims 1, 8, 25 and 31**, Lee discloses an apparatus for facilitating communications between a caller and a called party (column 1, lines 8-10), the apparatus comprising:

storage for storing a message for the called party provided by the caller, and data concerning a telephone number in association with the message for contacting the caller (column 3 line 44 to column 4, line 4) [The memory 18 stores the message for the called party and the telephone number associated with the calling party for callback];

a device for detecting a signal generated by the called party, which indicates an initiation of a call to the caller (column 5, lines 2-13) [The microprocessor 28 determines whether the command received from the called party is to dial the telephone that was stored in the memory 18]; and

a second interface responsive to the detected signal for retrieving from the storage the data concerning the telephone number stored in association with the message, a second connection to a communication device associated with the telephone number being established based on the retrieve data, the first connection being connected to the second connection through the communication network (column 5, lines 13-20) [The microprocessor 28 retrieves and transfers the phone number to the dialer 24 to automatically dials the telephone number through the telephone network interface inherently connecting the called party to the calling party].

Lee discloses prompting the caller to leave a message and a telephone number that the caller can be reached but fails to disclose an interface for prompting the caller to provide at least one preference concerning delivery of the message and a

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mechanism interface for initiating a first connection in accordance with the preference to deliver the message.

However, Matthews teaches an interface for prompting the caller to provide at least one preference concerning delivery of the message (column 57, lines 29-44) [The VMS 10 prompts the caller for the time and the date to deliver the message]; and

a mechanism interface for initiating a first connection in accordance with the preference to deliver the message therethrough to the called party, the first connection being established through a communication network (column 59, lines 37-53) [The feature delivery of the voicemail system 10 allows the caller to specify the time and date of delivery and proceeds according to the preference of the user].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Lee using the voicemail system as taught by Matthews.

This modification of the Lee's invention would allow the delivery of the messages defined by the caller preference so that the system will prevent stale messages from being delivered to a recipient who is not available.

Regarding **claims 2 and 26**, Lee discloses the message is recorded by the caller (column 3, lines 44-67).

Regarding **claims 3 and 27**, Lee discloses a message identification is assigned to the message for association with the telephone number (column 4, lines 51-65).

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Regarding **claims 5, 15, 23, 29, 38 and 46**, Lee discloses the telephone number is provided by the caller (column 3, lines 44-67).

Regarding **claims 6, 16, 24, 30, 39 and 47**, Lee discloses the signal includes a DTMF signal (column 2, lines 53-67).

Regarding **claims 7**, Matthews teaches a voice response unit (column 75, lines 63-68).

Regarding **claims 9 and 32**, Matthews teaches the preference includes a time range within which the message is delivered (column 57, lines 29-44).

Regarding **claims 10 and 33**, Matthews teaches the preference includes a number of attempts to deliver the message and the number of attempts is not greater than a predetermined maximum limit (column 25, lines 9-31).

Regarding **claims 11, 18, 34 and 41**, Lee discloses the call was unanswered due to a busy condition (column 3, lines 44-67).

Regarding **claims 12, 19, 35 and 42**, Lee discloses the call was unanswered due to a ring-no-answer condition (column 3, lines 44-67).

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Regarding **claims 13, 20, 36 and 43**, Lee discloses wherein the call was unanswered due to a communication problem (column 3, lines 44-67).

Regarding **claims 17 and 40**, Lee and Matthews disclose all the limitations of **claims 17 and 40** as stated in **claim 1**'s rejection and furthermore Lee discloses a server for providing a destination telephone number for contacting the desired party (column 2 lines 3-12) [The invention of FIG. 1 provides the telephone number for contacting the caller in the recorder 12].

6. **Claims 4, 14, 21-22, 28, 37 and 44-45** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view Matthews and in further view of Hammond (US 5,155,761).

Regarding **claims 4, 14, 22, 28, 37 and 45**, Lee and Yue as applied to **claims 1, 8, 25 and 31** differs from **claims 4, 14, 28 and 37**, in that it fails to disclose an automatic number identifier.

However, Hammond teaches the telephone number is derived from an automatic number identifier (column 4, lines 51-56).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the automatic number identifier of Hammond in the invention of Lee.



The modification of the invention would offer the capability of an automatic number identifier of an automatic callback for certain incoming calls.

Regarding **claims 21 and 44**, Hammond teaches an operator assisting the customer to obtain the information (column 5, lines 25-40).

### ***Response to Arguments***

7. Applicant's arguments with respect to **claims 1-47** have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**GERALD GAUTHIER**  
**PATENT EXAMINER**

g.g.  
November 30, 2004



**FAN TSANG**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**